

AUG 08 2005

Atty Docket No. 018512-003814US

PTO FAX NO.: (571) 273-8300

ATTENTION: Examiner Davis, Zinna Northington

Group Art Unit 1625

**OFFICIAL COMMUNICATION  
FOR THE PERSONAL ATTENTION OF  
EXAMINER ZINNA NORTHINGTON DAVIS**

**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that the following documents in re Application of Grant Andrew McNaughton-Smith, et al., Application No. 10/770,658, filed February 2, 2004 for BENZANILIDES AS POTASSIUM CHANNEL OPENERS are being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Documents Attached

1. Transmittal Form
2. Terminal Disclaimer to Obviate a Double Patenting Rejection Over a "Prior" Patent
3. Statement Under 37 CFR 3.73(b)
4. Fee Transmittal Form (in duplicate)

Number of pages being transmitted, including this page: 6

Dated: August 8, 2005

Cortney Gollands  
Cortney Gollands

**RECEIVED  
OIP/EI/AP  
AUG 11 2005**

**PLEASE CONFIRM RECEIPT OF THIS PAPER BY  
RETURN FACSIMILE AT (415) 576-0300**

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, CA 94111-3834  
Telephone: 858-350-6100  
Fax: 415-576-0300  
2591

\* Did not receive page 4/6. Chan

PTO/SB/21 (09-04)

<b>TRANSMITTAL FORM</b>  <small>(to be used for all correspondence after initial filing)</small>	Application Number	10/770,658
	Filing Date	February 2, 2004
	First Named Inventor	McNaughton-Smith, Grant A.
	Art Unit	1625
	Examiner Name	Davis, Zinna Northington
	Attorney Docket Number	018512-003814US
Total Number of Pages in This Submission		5

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input checked="" type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Postcard
Remarks: The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Townsend and Townsend and Crew LLP		
Signature	<i>Kenneth E. Jenkins</i>		
Printed name	Kenneth E. Jenkins, Ph.D.		
Date	August 8, 2005	Reg. No.	51,846

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office, Fax No. (571) 273-8300 on August 8, 2005.			
Signature	<i>Courtney Gollands</i>		
Typed or printed name	Courtney Gollands	Date	August 8, 2005

80558368 v1

AUG 08 2005

PTO/SB/17 (12-04)

Effective on 12/08/2004,  
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL**  
**For FY 2005**☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 65)

## Complete if Known

Application Number	10/770,658
Filing Date	February 2, 2004
First Named Inventor	McNaughton-Smith, Grant A.
Examiner Name	Davis, Zinna Northington
Art Unit	1625
Attorney Docket No.	018512-003814US

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_

☒ Deposit Account Deposit Account Number: 20-1430 Deposit Account Name: Townsend and Townsend and Crew LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2035

## FEE CALCULATION

## 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Small Entity	Fee (\$)	Small Entity	Fee (\$)	Small Entity	Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

## 2. EXCESS CLAIM FEES

Fee Description	Small Entity	Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
20 or HP =	x	=				
Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)			
3 or HP =	x	=				

HP = highest number of independent claims paid for, if greater than 3

## 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x		

## 4. OTHER FEE(S)


Non-English Specification, \$130 fee (no small entity discount)

Other: Terminal Disclaimer

Fees Paid (\$)

65

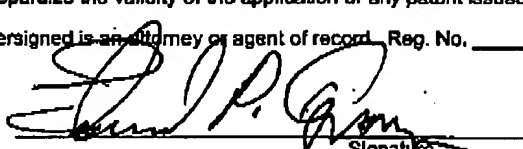
## SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	51,846	Telephone	858-350-6100
Name (Print/Type)	Kenneth E. Jenkins, Ph.D.			Date	August 8, 2005

60558384 v1

AUG 08 2005

PTO/SB/26 (09-04)

TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT	Docket Number (Optional) 018512-003814US
<p>In re Application of: Grant A. McNaughton-Smith</p> <p>Application No.: 10/770,658</p> <p>Filed: February 2, 2004</p> <p>For: BENZANILIDES AS POTASSIUM CHANNEL OPENERS</p> <p>The owner, <u>ICAGEN, Inc.</u>, of <u>100%</u> percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term prior patent No. <u>6,372,767</u> as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.</p> <p>In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:</p> <ul style="list-style-type: none"><li>expires for failure to pay a maintenance fee;</li><li>is held unenforceable;</li><li>is found invalid by a court of competent jurisdiction;</li><li>is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;</li><li>has all claims canceled by a reexamination certificate;</li><li>is reissued; or</li><li>is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.</li></ul> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input checked="" type="checkbox"/> For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <p>2. <input type="checkbox"/> The undersigned is an attorney or agent of record. Reg. No. _____</p> <p> Signature</p> <p><u>7/29/05</u> Date</p> <p><u>Edward P. Gray</u> Typed or printed name</p> <p><u>619-941-5206</u> Telephone Number</p> <p><input checked="" type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) is included.</p> <p><b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b></p> <p>*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.</p>	

60540125 v1

08/11/2005 ZJUHR1 00000005 201430 10770658

01 FC:2814

65.00 DA

PTO/SB/86 (09-04)

Attorney Docket No. 018512-003814US

**STATEMENT UNDER 37 CFR 3.73(b)**Applicant/Patent Owner: Grant Andrew McNaughton-Smith, et al.Application No./Patent No.: 10/770,658 Filed/Issue Date: February 2, 2004Entitled: BENZANILIDES AS POTASSIUM CHANNEL OPENERSICAgen, Inc. a corporation  
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest.  
The extent (by, percentage) of its ownership interest is \_\_\_\_\_ %

In the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 011380, Frame 0577, or for which a copy thereof is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.☐ Additional documents in the chain of title are listed on a supplemental sheet.☐ Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.8]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

  
Signature

Edward P. Gray

Printed or Typed Name

Senior Vice President, General Patent Counsel

Title

2/29/05  
Date919-941-5206  
Telephone Number